

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAM W. RAY

Appeal No. 1997-0820
Application No. 08/364,541¹

ON BRIEF

Before KIMLIN, PAK and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-5 and 10-13. Claims 6-9, the other claims remaining in the

¹ Application for patent filed December 27, 1994. According to appellant, this application is a continuation of Application No. 08/018,014, filed February 16, 1993.

Appeal No. 1997-0820
Application No. 08/364,541

present application, stand withdrawn from consideration.

Claim 1 is illustrative:

1. A method of densifying expanded thermoplastic material without injecting external heat comprising the steps of:

(a) confining particles of expanded thermoplastic material in a container; and

(b) reducing the volume of said container and simultaneously uniformly agitating said particles until substantially all said particles form a single substantially unitary mass of softened material within said container.

The examiner has not cited prior art in his rejection of the appealed claims.

According to appellant, the present invention relates to "densifying and reusing expanded or foamed thermoplastic wastes and the like and reforming them into usable end products without externally-injected heat" (page 5 of principal brief).² Appellant's specification relates that "[b]y simultaneously agitating and compressing the material, the energy produced by frictional forces is contained within the mass of material itself, thus producing a liquid mass with minimum consumption of energy" (page 2).

² The pages of the principal and reply briefs have not been numbered by appellant.

Appeal No. 1997-0820
Application No. 08/364,541

Appealed claims 1-5 and 10-13 stand rejected under
35 U.S.C. § 112, first paragraph.³

Upon careful consideration of the opposing arguments
presented on appeal, we will not sustain the examiner's
rejection.

It is the examiner's position that the claim language
"without injecting external heat" lacks descriptive support in
the original specification. However, while the examiner is
correct that the criticized claim language is not described in
ipsis verbis in the original specification, such is not
required by § 112, first paragraph. In re Herschler, 591 F.2d
693, 701, 200 USPQ 711, 717 (CCPA 1979); In re Smith, 481 F.2d
910, 914, 178 USPQ 620, 624 (CCPA 1973). The proper inquiry
is whether the original specification reasonably conveys to
one of ordinary skill in the art that the inventor had in his
or her possession, as of the filing date of the application,
the later added limitation. Vas-Cath Inc. v. Mahurkar, 935
F.2d 1555, 1563,

³ The examiner has withdrawn the rejection under
35 U.S.C. § 112, second paragraph (see page 2 of Answer).

Appeal No. 1997-0820
Application No. 08/364,541

19 USPQ2d 1111, 1116 (Fed. Cir. 1991). To make this evaluation it must be determined whether the concept embodied by the new language is present in the original specification. In re Anderson, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973).

Based on the facts of the present case, our reading of the original specification brings us into agreement with appellant that the original specification, considered in its entirety as a whole, reasonably conveys to one of ordinary skill in the art the concept that the method of densifying expanded thermoplastic material is performed by agitating confined particles of thermoplastic material without the injection of external heat. In our view, the original specification conveys that the whole point of the present invention is to avoid the costly prior art process of utilizing external heat which consumes tremendous amounts of energy and is, therefore, not commercially viable (page 2 of specification, lines 17-22).

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

Appeal No. 1997-0820
Application No. 08/364,541

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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THOMAS A. WALTZ)	
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ECK:clm

Appeal No. 1997-0820
Application No. 08/364,541

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